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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/594,673 | 06/16/2000 | Alan Fisher | 0064738-0050 | 6577 |
| 31013 | 7590 | 03/17/2004 | EXAMINER | |
| KRAMER LEVIN NAFTALIS & FRANKEL LLP INTELLECTUAL PROPERTY DEPARTMENT 919 THIRD AVENUE NEW YORK, NY 10022 | | | WEBMAN, EDWARD J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
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| ART UNIT | PAPER NUMBER |
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2/22/04

DATE MAILED:

This is a communication from the examiner in charge of your application.
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OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 11/10/03☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-109 is/are pending in the application.☐ Of the above, claim(s) 1-21, 25-86, 89-109 is/are withdrawn from consideration.☐ Claim(s) _____ is/are allowed.☒ Claim(s) 22-24, 87-88 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-24, 87-88 are rejected under 35 U.S.C. 102(b) as being anticipated by Bening et al 1990.

Bening et al 1990 teach nanotubules reacted with potassium chlorate in sulfuric acid (p.420, "experimental section", under "oxidation"). Carboxyl groups, phenol groups, aldehydes, and hydroxyl groups are specified. Esterification and carboxylic acid labeling with Thallium is disclosed ("results and discussion" p.420-421).

Claims 21-24, 87-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Nowhere in the specification do applicants disclose how to make functionalized graphic nanofibrils as claimed in claim 22 where R is $SR'_i S_j (OR')_y -R'_{3-y}$, $S_j (O-S_j R'_2) -OR'$, $H_g X$, and $M_g X$.

Applicants argue that they are entitled to the above species whether or not they are taught specifically because they are well-known in the art and in view of textbook reactions. However, applicants do not disclose how to attach the claimed species to the claimed species to the claimed nanotubules. The fact that the species and textbook

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reactions are well-known does not overcome the rejection because neither concerns reactions with nanotubes.

No claims allowed.

Any inquiry concerning this communication should be directed to Edward J. Webman at telephone number 571-272-0633.

Webman/tgd

February 24, 2004



EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500